UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/688,441	10/16/2000	Bayard S. Webb	0112300/141	1896

29159 7590 02/23/2006

BELL, BOYD & LLOYD LLC
P. O. BOX 1135
CHICAGO, IL 60690-1135

EXAMINER	
MCCULLOCH JR, WILLIAM H	
ART UNIT	**PAPER NUMBER**
3714	

DATE MAILED: 02/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/688,441	WEBB ET AL.	
	Examiner	Art Unit	
	William H. McCulloch Jr.	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 January 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18 and 20-38* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *29-38* is/are allowed.

6)☒ Claim(s) *1-18 and 20-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20 December 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to applicant's amendment received on 1/24/2005. The current application has claims 1, 13, 24, and 31 amended, claim 19 canceled, claims 29-38 allowed. All other claims 2-12, 14-18, 20-23, and 25-28 remain as previously presented.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1, 2, 13, 22, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over G.B. 2,144,644 to Barrie in view of U.S. 6,149,156 to Feola and U.S. 5,855,514 to Kamille. This rejection was stated in a previous office action and is maintained and incorporated herein.

Regarding claims 1 and 13: Barrie discloses a gaming machine having player selections over multiple rounds, the device providing dramatic narration. The game is governed by chance and the player makes choices to progress through game-play. The player's choices may result in dramatic scenes on a screen, depicting whether the player has lost a game or won a reward. The player may have an opportunity to choose a reward or choose to continue play for the possibility of earning a greater reward. Individual outcomes are based upon chance. See abstract.

Barrie's disclosure teaches the following:

1) displaying a plurality of symbols (doors) on a display (figure 3),

2) a plurality of rounds (figures 9 and 9A, and p. 2:23-76)

3) a means for enabling a player to select on of the symbols in each of the rounds (p. 1:42-47).

4) a display device operable for displaying the plurality of symbols (figure 1)

5) a controller operable with the selection means and the display device to randomly assign an item to at least one, a plurality, or all of the plurality of symbols, to enable the player to select one of the symbols in each of the rounds, and to provide an award to the player if the player selects on of the symbols having an assigned item (figure 2, and p. 1:48-54 and 2:6-22).

Barrie does no describe the use of independent rounds or determining whether to assign an item to all of the plurality of symbols. Feola discloses a selection game having multiple rounds. Feola's device employs independent rounds (1:56-67). The reference states that a player does not need to play an earlier round in order to play a later round. The result is that the game is made more interesting and exciting because a player can win in later rounds even if he loses in an earlier round (Feola 1:64-67). Thus, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the gaming device of Barrie, wherein a player participates in multiple rounds, to add the feature of making the rounds independent.

Barrie describes a gaming system as described above. Kamille discloses an analogous gaming device for playing a selection game (3:59-4:3). Kamille's device

includes 'win' or 'lose' outcomes. Kamille teaches that the game selections may all be winning outcomes (1:56-2:3). The probability of winning is controlled, which contributes to the game's popularity. Thus, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Barrie's device to add the feature of assigning an item to all of the plurality of symbols. As suggested by Kamille, the modification would allow the operator to provide a game in which some outcomes are guaranteed to win and thereby increase the popularity of the game.

Regarding claim 2, Barrie teaches having the controller assign an item to a plurality of symbols in each round (figures 3-9 and 3:1-19).

Regarding claim 22, as described above, Barrie teaches revealing that a symbol has been assigned an item when the player selects a symbol having the assigned item.

Regarding claim 23: The multi-round gaming device suggested by Barrie in view of Feola and Kamille describes all the features of the instant claims except revealing that all symbols having an assigned item indeed have an assigned item. Regardless of the deficiency, the feature was known in the art at the time of the invention and would have been obvious to an artisan. It is known in the art to reveal unselected selections from a set of hidden selections to demonstrate that a selection associated with an item actually existed. Revealing unselected items assures players that the game is not a scam such as a "Shell Game" or "Three-Card-Monty", wherein there is actually no winning outcome. Furthermore, revealing unselected items serves to entice players by satisfying their curiosity in forgone possibilities. Thus, in multi-round gaming device described by Barrie in view of Feola and Kamille, wherein players select items hidden

behind a plurality of symbols, it would have been obvious to one of ordinary skill in the art at the time of the invention to reveal that all symbols having an assigned item indeed have an assigned item to demonstrate the game is not a scam and entice players into further attempts by revealing the forgone selections. The modification would enhance the gaming device by increasing players' feelings of fairness and excitement and thereby increase operator revenue.

4. Claims 3, 4, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrie in view of Feola and Kamille (as applied above), and in further view of U.S. 6,203,429 to Demar et al. This rejection was stated in a previous office action and is maintained and incorporated herein.

Regarding claim 3: The gaming device suggested by Barrie in view of Feola and Kamille describes all of the features of the claim except selecting items from a table. Demar teaches a gaming device in which items are randomly selected from a table (figures 13A, 13B, 14, and 15). By arranging the items in a table, the device provides a means to associate the item with another value. For example, figure 13A illustrates a table associating items with probabilities wherein each item has a different probability of occurring. In view of Demar, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the gaming device suggested by the combination of Barrie in view of Feola and Kamille, wherein different items are randomly associated with selections, to add the feature of selecting the items from a table. As taught by Demar, the modification would provide a means to associate the item with another value and thereby control probability of occurrence of each item.

Regarding claims 4, 11, and 12, Demar teaches a table of randomly selectable items wherein at least one item is adapted to be randomly selected more often than another item (figures 13A, 13B, 14, and 15).

5. Claims 14, 17, and 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrie in view of Feola and Kamille (as described above), and in further view of U.S. 6,427,208 to Yoseloff et al. This rejection was stated in a previous office action and is maintained and incorporated herein.

Regarding claims 14, 17, and 24: The gaming device described by Barrie in view of Feola and Kamille describes all of the features of the instant claims except selecting the number of rounds that the player has in the selection game. Yoseloff describes an analogous game system having multiple rounds in which the number of rounds the player has in the game is randomly determined prior to initiating the game (4:36-50). Thus, the length of the game is limited without being predictable by the player. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the gaming device suggested by the combination of Barrie in view of Kamille to add the feature of employing a table of numbers to designate the number of rounds the player has in the selection game. As taught by Yoseloff, randomly determining the number of rounds prior to initiating a game allows operators to limit the length of the game without being predictable by the player. Thus, the game operator's revenue will be preserved while enhancing the enjoyment of players.

Regarding claim 25, Barrie teaches selecting a prize (figure 2 and 1:48-54 and 2:6-22).

Regarding claim 26, Barrie teaches providing a prize to a player if the player chooses a symbol having an assigned item (see above).

Regarding claim 27, Barrie teaches revealing that a symbol has an assigned item when the player selects a symbol having the assigned item (see above).

Regarding claim 28, the gaming device suggested by Barrie with Feola, Kamille and Yoseloff describes all the features of the instant claims except revealing that all symbols having an assigned item indeed have an assigned item. It was known in the art at the time of invention to reveal unselected selections from a set of hidden selections to demonstrate that a selection associated with an item actually existed. Revealing unselected items assures players that the game is not a scam such as a "Shell Game" or "Three-card-Monty", wherein there is actually no winning outcome. Furthermore, revealing unselected items serves to entice players by satisfying their curiosity in forgone possibilities. Thus, in multi-round gaming device suggested by the combination of Barrie in view of Feola, Kamille and Yoseloff, wherein players attempt to select items hidden behind a plurality of symbols, it would have been obvious to one of ordinary skill in the art at the time of the invention to reveal that all symbols having an assigned item indeed have and assigned item to demonstrate the game is not a scam and entice players into further attempts by revealing the forgone selections. The modification would enhance the gaming device by increasing players' feelings of fairness and excitement and thereby increase operator revenue.

6. Claims 5-10 and 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrie in view of Kamille and Demar (as applied above), in further

view of Yoseloff. This rejection was stated in a previous office action and is maintained and incorporated herein.

Regarding claims 5, 15, 18, and 20: The combination of Barrie with Feola, Kamille and Demar describes all the features of the instant claims except employing the table of numbers to designate the number of rounds the player has in the selection game. Yoseloff describes an analogous gaming device having multiple rounds in which the number of rounds the player has in the game is randomly determined prior to initiating the game (4:36-50). As a result, the length of the game is limited without being predictable by the player. In view of Yoseloff, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the gaming device suggested by the combination of Barrie with Feola, Kamille and Demar, wherein different items are randomly selected from a table, to add the feature of employing a table of numbers to designate the number of rounds the player has in the selection game. As taught by Yoseloff, randomly determining the number of rounds prior to initiating a game allows operators to limit the length of the game without being predictable by the player. As a result, operator's revenue will be preserved while enhancing the enjoyment of players.

Regarding claims 6 and 16, Demar teaches a table of randomly selectable items wherein at least one number is adapted to be randomly selected more often than another number (figures 13A, 13B, 14, and 15).

Regarding claim 7, Demar teaches a plurality of tables of numbers (see above).

Regarding claim 8, Demar teaches a table of randomly selectable items wherein at least one number is adapted to be randomly selected more often than another number (see above).

Regarding claim 9, Demar teaches the gaming device suggested by the combination of Barrie with Kamille and Demar and Yoseloff teaches all of the features of the claim except having a quantity of tables of numbers equaling the quantity of symbols in a round. Demar describes a gaming device in which values for some items are randomly selected from a table providing a means to associate the item with another value, such as an occurrence rate, in order to provide a variable outcome (figures 13A, 13B, 14, and 15). Thus, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the device of Barrie combined with Kamille, Demar, and Yoseloff, to add the feature of having a quantity of tables of numbers equaling the quantity of symbols in a round to provide a variable outcome for each item and thereby enhance players' enjoyment by making the game less predictable.

Regarding claim 10, Demar teaches a table of randomly selectable items wherein at least one number is adapted to be randomly selected more often than another item (see above).

Regarding claim 21, Barrie discloses changing the probability of selecting a winning symbol in each round. Therefore, the gaming device suggested by the combination of Barrie with Kamille, Demar, and Yoseloff, wherein the number of rounds and/or item probability is selected from a table, it would have been obvious to one of ordinary skill in the art at the time of invention to allow for the selected number of rounds

of each to be associated with a different percentage of symbols having an assigned item.

Allowable Subject Matter

7. Claims 29-38 are allowed, as described in the previous office action.

Response to Arguments

8. Applicant's arguments, see page 1 of applicant's remarks, filed 1/25/2005, with respect to the rejection of claims 1, 13, and 24 under 35 U.S.C. 112 have been fully considered and are persuasive. Applicant has clarified that the determination of whether to assign an item to a symbol in one round is independent of other rounds. Thus, the rejection of claims 1, 13, and 24 has been withdrawn.

9. Applicant's arguments filed 1/25/2005 with regard to rejections under 35 U.S.C. 103(a) have been fully considered but they are not persuasive.

Applicant argues that the combination of Barrie and Kamille is not proper because Barrie teaches away from the feature of assigning one item to all of the symbols as disclosed in Kamille. Applicant further contends that the combination of Barrie and Feola is not proper because Barrie's concept of following a path teaches away from Feola's independent round feature.

Feola teaches that having multiple rounds provides more excitement since, even if a player loses earlier rounds, he/she can still win later rounds (1:64-67). In essence, Feola teaches that giving a game player multiple chances to win will keep the player interested in the game. Barrie teaches that the primary object of his invention is to provide payers a more "imaginative display" than other games, by providing a "dramatic

narration involving chance" (p.1, lines 26-34). Though Barrie does not disclose independent rounds, the combination of Barrie with Feola to include independent rounds does not diminish the artistic objectives or intended purposes of Barrie, but instead offers an improvement to players' experience by allowing them to win games independently. As discussed above, these independent rounds are known to keep players interested in playing a particular game, and since this is a major objective of those skilled in the art, it would have been an obvious modification to Barrie.

Regarding the combination of Barrie and Kamille, the applicant argues that Barrie teaches the need for at least two classes which must be assigned to different doors. Applicant further contends that if Barrie is combined with Kamille, then the premise of Barrie, meaning the opportunity of obtaining either a win class or a lose class with each symbol selection, would not be feasible. The examiner notes that Kamille provides games that are "assured winners", "assured losers", or games that have a probability of winning that is greater than 0% and less than 100% (for example 5:21-26). Kamille further teaches controlling the number of winning outcomes in order to prevent unnecessarily large payout liabilities on the part of a gaming establishment (for example column 2). In summary, Kamille teaches applying an item to all of the plurality of symbols in a way that is beneficial to both the game player and the gaming establishment. The examiner notes that Barrie's device could provide a round of a game wherein the player is guaranteed to win (i.e. an item is assigned to all of the plurality of symbols) without any detriment to the profitability and overall system, as long

as the frequency of a winning condition is controlled, as is suggested by Kamille. Thus, the combination of Barrie and Kamille is feasible and obvious.

The applicant contends that because a combination of Barrie in view of Kamille and Feola is improper, the office action cannot further combine these references with Demar or Demar in view of Yoseloff. The examiner has shown above that the previous office action did properly combine these references, and therefore maintains that combinations of Demar or Demar in view of Yoseloff are also proper in view of the above explanations. The applicant accused the examiner of applying improper hindsight. The applicant further asserted that the office action picked and chose elements from five different sources. However, the examiner has shown that the previous rejection properly combined the sources and the examiner notes that there is no restriction on the number of sources that may be combined under 35 U.S.C. 103(a) as long as the references are properly combined. Thus, for the reasons stated herein the previous rejection is deemed proper.

Citation of Pertinent Prior Art

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. 5,833,537 to Barrie discloses a gaming apparatus and method with persistence effect. U.S. 6,089,976 to Schneider et al. shows a gaming apparatus and method including a player interactive bonus game. U.S. 6,364,766 to Anderson et al. describes a gaming machine with sorting feature. U.S. 6,261,177 to Bennett describes a game with a game image having a plurality of player selectable zones, the control means including player zone selection means, and a prize being

associated with at least one of the zones. U.S. 6,015,346 to Bennett discloses an indicia selection game.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. McCulloch Jr. whose telephone number is (571) 272-2818. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Jones can be reached on (571) 272-4438. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

William H. McCulloch Jr.
Examiner
Art Unit 3714
2/13/2006

wm

JOHN M. HOTALING, II
PRIMARY EXAMINER